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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE THE APPLICATION OF:

Yoshino

Grp. Art. Unit: 3745

Application No: 10/714171

Date: September 12, 2005

Filed: November 14, 2003

Examiner: F. D. Lopez

POWER SYSTEM AND WORK  
MACHINE USING SAME

Atty Docket: 03-227

RESPONSE TO OFFICE ACTION

In response to the Final Office Action dated July 19, 2005, and the telephone interview of September 12, 2005, please consider the following remarks. Reconsideration of the present application is respectfully requested.

Claims 1-17 stand rejected under 35 USC §103 over Japan 2002-195,218 in view of Maruita et al. Applicant concedes that the Japanese reference, which is by the same inventor, shows much of the claimed invention except for the variable displacement hydraulic motor. In addition, Applicant concedes that Maruita et al. teaches a variable displacement pump/motor in a disclosure entitled Pressure Oil Energy Recovery/Regeneration Apparatus. However, Applicant respectfully asserts that there is no support in the cited references, in the MPEP or the relevant case law for the notion that one with ordinary skill in the art would be motivated to replace the throttle valve and constant displacement motor of the Japanese reference with the variable displacement motor taught by Maruita et al. to arrive at Applicant's claimed invention.

The office action asserts that the throttle valve and constant displacement motor of the Japanese reference is the functional equivalent of the variable displacement motor of Maruita et al., and therefore, one with ordinary skill in the art would find it obvious to replace the one for the other as a matter of engineering expediency. Although the MPEP and relevant case law allow a prima facie §103 rejection to be based upon the substitution of equivalents known for a similar purpose, the MPEP and relevant case law require that the equivalency between the two components be recognized in the art. See MPEP §2144.06; and, In re Scott, 323 F.2d 1016, 139

USPQ 297 (CCPA 1963). In this case, there is no evidence that the throttle valve and fixed displacement motor are functionally equivalent to a variable displacement motor as asserted in the office action. And even if they were, that supposed equivalency is not recognized in the cited art. The proof in the lack of equivalency lies the fact that if one were to substitute the throttle and fixed displacement motor of the Japanese reference in place of the supposedly equivalent variable displacement motor of Maruta et al., the Maruta et al. device would not be able to perform in the manner described by that reference. And if the opposite were done as per the rejection, the cited Japanese system would be improved, rather than remain unchanged or equivalent. In other words, the identified components are not equivalent. Based upon the telephone interview, the Examiner appears to believe that the mandates of MPEP §2144.06 and the relevant case law are satisfied merely by showing that a reference in an analogous art has shown usage of the component in question; but the MPEP and the relevant case law require more. In this case, a variable displacement motor is superior to a throttle and fixed displacement motor, and only Applicant's disclosure recognizes this superiority. There should be no dispute that when something is superior to something else, it can inherently not also be equivalent to that thing. Therefore, the rejections under §103 in the present application fail for at least two reasons, and should be withdrawn.

With regard to functional equivalency, Applicant respectfully asserts that the variable displacement hydraulic motor of the claimed invention allows for controlling torque from the motor in the face of variable pressures and flow rates in a way not believed possible with a simple throttle valve and fixed displacement motor. Thus, the presently claimed invention is an improvement upon the inventor's previous work disclosed in the Japanese reference. Applicant respectfully challenges the Examiner to make evidence of record to support the notion that the throttle valve and fixed displacement motor is the functional equivalent of a variable displacement motor. If not, the rejections should be withdrawn. In addition, because there is apparently no dispute that the asserted equivalency is not recognized in the art, the rejections should again be withdrawn. Applicant should not be forced into an appeal to have at least two long held standards under §103 fairly applied to the case at hand. Applicant respectfully requests that either the evidence required by the MPEP be made of record and that prosecution be reopened, or that the rejections be withdrawn in favor of a Notice of Allowance.

During the telephone interview of September 12, 2005, the Examiner acknowledged that MPEP §2144.06 was directly applicable to the case at hand, but the Examiner conceded that he had not reviewed that MPEP section before issuing his Office Action, nor in preparation for the telephone interview which specifically identifies that section. Then, during the interview, the Examiner asserted that the art need not expressly recognize the equivalency of the two things in question. However, this assertion again is faulty as the MPEP § in question merely states that an express suggestion to substitute the two things one for the other is not required. But the Office Action does not even contain an utterance as to where one can glean the supposedly recognition of equivalency from the cited art. Instead, Applicant's claimed invention is clearly superior to that of his earlier work, not equivalent. And the Examiner has identified not a single utterance in the art of record to show that either Applicant, the Japanese system or the Maruta et al. hydraulic circuits would perform equivalent by including either a throttle and fixed displacement motor or a variable displacement motor. They simply would not. Applicants should not be force into appeal to have the MPEP and relevant case law at least acknowledged and fairly applied to the case at hand, rather than being overlooked and then stubbornly ignored.

This application is believed to be in condition for allowance of claims 1-17. However, if the Examiner believes that some minor additional clarification would put this application in even better condition for allowance, the Examiner is invited to contact the undersigned attorney at (812) 333-5355 in order to hasten the prosecution of this application.

Respectfully Submitted,



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